REMARKS

Claims 1, 3, 5-10, 12, 14-16, 18, 20-22, 24 and 26-45 are pending and under consideration in this application. Claims 1, 3, 10, 12, 16, 18, 22, 24, and 28 are amended herein. Support for the amendments to the claims may be found in the claims as originally filed, and in the specification from page 8, line 23 to page 10, line 5. Claims 37-45 are added herein. This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Further reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. The Applicants, in particular, are disappointed to have received no response to the argument that the Johnson reference, for example, is incapable of teaching one of skill in the art how to make and use the claimed invention, and is thus incapable of anticipating the claimed invention. Similar arguments were made with respect to the other non-patent literature references. The arguments were made in good faith, and are believed to be supported by the facts and by the law. The Applicants thus reiterate their request for some explanation as to why the arguments with respect to the lack of enablement of the non-patent literature references was not found to be persuasive. Further reconsideration is thus requested.

Claim Rejections - 35 U.S.C. § 102:

Claims 1, 10, 16, 22, 28, and 29 were rejected under 35 U.S.C. § 102(b) as anticipated by Johnson, *Bookmark Organizer Ready*, Electronic Engineering Times, July 31, 1995, pg. 140 (pgs. 1 and 2 as printed from ProQuest.) (hereinafter "Johnson"). The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration of the rejection is earnestly solicited.

The fourth clauses of claims 1, 10, 16, 22, and 28 recite:

Obtaining, together with the various image data provided by the server which are displayed on the Web browser in the client, URLs in which said various image data are published and information relating to said various image data, and managing the information relating to said various image data as attributes of said various image data.

Johnson neither teaches, discloses, nor suggests "obtaining, together with the various image data provided by the server which are displayed on the Web browser in the client, URLs in which said various image data are published and information relating to said various image data, and managing the information relating to said various image data as attributes of said various image data," as recited in claims 1, 10, 16, 22, and 28.

Johnson, rather, only discusses organizing web pages into user-defined hierarchical directories. Simply dragging and dropping a URL along with an image into a folder does not amount to "obtaining, together with the various image data provided by the server which are displayed on the Web browser in the client, URLs in which said various image data are published and information relating to said various image data, and managing the information relating to said various image data as attributes of said various image data," as recited in claims 1, 10, 16, 22, and 28.

The final Office Action asserts in section 14 at page 20 that:

> Johnson discloses images displayed on the Internet of the web browser (page 1) where the image is dragged-and-dropped or copied and pasted along with a URL. This suggests that the images, when dragged-and-dropped or copied and pasted would go along with the URLs.

This is submitted to be without basis. All Johnson says is that if the user indicates into which folder a URL should be stored by dragging and dropping an image on the folder, Grabnet will automatically transfer the underlying URL into the folder. Nothing is said in Johnson about "obtaining, together with the various image data provided by the server which are displayed on the Web browser in the client, URLs in which said various image data are published and information relating to said various image data, and managing the information relating to said various image data as attributes of said various image data," contrary to the assertion in the final Office Action.

Furthermore, even if, as asserted in the final Office Action, Johnson "suggests" that the images, when dragged-and-dropped or copied and pasted would go along with the URLs, 35 U.S.C. §102(b), under which the rejection was made, has no provision for anticipation by suggestion. 35 U.S.C. §102(b), rather, requires that:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

Clearly, even if it were true that Johnson *suggested* that the images, when dragged-and-dropped or copied and pasted would go along with the URLs, that still would not amount to being patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, as required by 35 U.S.C. §102(b).

The fifth clauses of claims 1, 10, 16, 22, and 28 recite:

Displaying said various image data in the application of the client at the position of the mouse cursor.

Johnson neither teaches, discloses, nor suggests "displaying said various image data in the application of the client at the position of the mouse cursor," as recited in claims 1, 10, 16, 22, and 28. Johnson, rather, only discusses organizing web pages into user-defined hierarchical directories. Simply dragging and dropping a URL along with an image into a folder does not amount to "displaying said various image data in the application of the client at the position of the mouse cursor," as recited in claims 1, 10, 16, 22, and 28.

Claim 29 recites:

Updating an image attribute in the application with a URL at which the image is available and with image identification information relating to the image.

Johnson neither teaches, discloses, nor suggests "updating an image attribute in the application with a URL at which the image is available and with image identification information relating to the image," as recited in claim 29. The final Office Action considers the URL to be identification information relating to the image, in the last line of section 5, at page 5. The URL is already recited in claim 29 as a URL, however, and thus it cannot *also* meet the recitation "image identification information relating to the image." Furthermore, using the WWW page's title as the index entry, as noted in section 5 at page 5, is simply tracing the origin of the image with the URL, not "updating an image attribute in the application with a URL at which the image is available and with image identification information relating to the image," as recited in claim 29.

The final Office Action asserts in section 14, at the top of page 21 that "the image, when dropped or pasted in the application, is inserted in the application." This is submitted to be without basis. In Johnson, rather, images are only needed for the user to show into which folder they'd like to place the URL. Since the URL can be followed to the image, as long as it is not stale, there is no need in Johnson for the image to *also* be inserted.

Furthermore, in order for Johnson to serve as an anticipating reference, Johnson must enable that which it is asserted to anticipate. "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled."

Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CAFC 2003):

Here, Johnson, at most, recounts a result produced by others, with no enabling details at all. Hence, Johnson cannot anticipate claims 1, 10, 16, 22, 28 and 29, regardless of what it recounts, since it does not enable claims 1, 10, 16, 22, 28 and 29. Claims 1, 10, 16, 22, 28 and 29 are submitted to be allowable. Withdrawal of the rejection of claims 1, 10, 16, 22, 28 and 29 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, 30, 31, and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle, *BricsNet Acquires Leading Online Provider of Building Industry*, Business Wire, Oct. 26, 1999, page 1 (pgs 1-3 as printed from Pro Quest (hereinafter "Stierle") in view of Cunningham, *Built for Existing Users not the First-Timer*, Computing Canada, August 5, 1007, vol. 23, Iss. 16, pg. 28 (pages 1-3 as printed from ProQuest (hereinafter "Cunningham") and Puttre, *CAD Vendors Wrap Engineers in World Wide Web*, Design News, Feb. 17, 1997, vol. 52, Iss. 4, pg 58, (pages 1-5 as printed from ProQuest (hereinafter "Puttre"). The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

The present invention (see claims 1, 3, 10 ,12, 16, 18, 22, 24, 28, 29 and 30) is directed to a system, process or medium by which an image (a CAD part) can be inserted into a users application (a CAD application). CAD parts have attributes, such as a path to a library containing the part, identification of a reference point for the part, etc. (see figure 6). When the part image is inserted into the application, the URL location for the image, or where it is published along with information about the image, such as the title of the page where the image is available, are used to update the attributes of the part in the CAD application. That is, the URL is made into an attribute of the CAD part and managed as an attribute. None of the cited references teach or suggest this.

The fourth clauses of claims 3, 12, 18, and 24, in particular, recite:

Obtaining, together with the various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data.

Neither Stierle, Cunningham nor Puttre teach, disclose, or suggest "obtaining, together with the various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data," as recited in claims 3, 12, 18, and 24.

Puttre, rather, describes posting CAD images on the Internet. The flow of information in Puttre is, therefore, exactly opposite to that of the claimed invention. Puttre would thus have no interest in "obtaining, together with the various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data," since the client is supposed to be posting CAD images to the Internet, not the other way around.

Furthermore, the "hot link" of Puttre appears to be a regular file link, not a URL. The hot link of Puttre, rather, associates the files of the computer with one another. Puttre is thus not "obtaining, together with the various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data," since the hot link is not a URL.

The fifth clauses of claims 3, 12, 18, and 24 in particular, recite:

Displaying said various CAD parts data in the application of the client at the position of the mouse cursor in a rubber-banding format.

Neither Stierle, Cunningham nor Puttre teach, disclose, or suggest "displaying said various CAD parts data in the application of the client at the position of the mouse cursor in a rubber-banding format," as recited in claims 3, 12, 18, and 24. Thus, even if Stierle, Cunningham and Puttre were combined, the claimed invention would not result.

Claims 5, 6, 14, 15, 20, 21, 26, 27, and 31 depend from claims 3, 12, 18, or 24 and add further distinguishing elements. Claims 5, 6, 14, 15, 20, 21, 26, 27, and 31 are thus also

submitted to be allowable, for at least those reasons discussed above with respect to the rejections of claims 3, 12, 18, and 24.

Claim 30 recites:

Updating a CAD part attribute of the CAD part in the CAD application with a URL at which the CAD part and part image are available and with CAD part identification information relating to the CAD part.

Neither Stierle, Cunningham nor Puttre teach, disclose, or suggest "updating a CAD part attribute of the CAD part in the CAD application with a URL at which the CAD part and part image are available and with CAD part identification information relating to the CAD part," as recited in claim 30. The final Office Action acknowledges graciously in section 8 at page 8 that Cunningham does not disclose, "information relating to said various CAD parts data as attributes of the CAD parts data," so Cunningham must not be updating "a CAD part attribute of the CAD part in the CAD application with a URL at which the CAD part and part image are available and with CAD part identification information relating to the CAD part," as recited in claim 30, either.

Furthermore, the flow of information in Puttre is exactly opposite to that of the claimed invention, as discussed above, so Puttre must not be updating "a CAD part attribute of the CAD part in the CAD application with a URL at which the CAD part and part image are available and with CAD part identification information relating to the CAD part," as recited in claim 30, either.

Finally, a reference must enable a claim in order to anticipate the claim, as discussed above. Here, neither Stierle, Cunningham nor Puttre do anything more than recount a result produced by others, with no enabling details at all. Hence, neither Stierle, Cunningham nor Puttre can render claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, 30, 31, and 34 unpatentable, regardless of what they recount, since they do not enable claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, 30, 31, and 34. Claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, 30, 31, and 34 are thus submitted to be allowable. Withdrawal of the rejection of claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, 30, 31, and 34 is earnestly solicited.

Claims 7, 32, 33, and 36:

Claims 7, 32, 33, and 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle, Cunningham, and Puttre. The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

Claims 7, 32, 33, and 36 depend from claim 3 and add further distinguishing elements. Neither Stierle, Cunningham nor Puttre teach, disclose, or suggest "obtaining, together with the

various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data," as discussed above with respect to the rejection of claim 3. Claims 7, 32, 33, and 36 are thus also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 3. Withdrawal of the rejection of claims 7, 32, 33, and 36 is earnestly solicited.

Claim 8:

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle Cunningham, and Puttre, and further in view of Smith, *Collaborate on the Web*, CADalyst, Feb. 1999, vol. 16, Iss. 2, pg 58, (pages 1-8 as printed from ProQuest (hereinafter "Smith"). The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

Claim 8 depends from claim 3 and adds further distinguishing elements. Neither Stierle, Cunningham nor Puttre teach, disclose, or suggest "obtaining, together with the various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data," as discussed above with respect to the rejection of claim 3. Smith does not either, and thus cannot make up for the deficiencies of either Stierle, Cunningham or Puttre with respect to claim 8.

Smith, rather, describes a virtual work site where multiple users share and discuss designs, etc. All of the activity occurs on the virtual work site, with none occurring at the client. Smith would thus have no interest in "obtaining, together with the various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data," since the client shouldn't be doing anything where the other team members can't see in any case.

Furthermore, a reference must enable a claim in order to anticipate the claim, as discussed above. Here, neither Stierle, Cunningham, Puttre, nor Smith do anything more than recount results produced by others, with no enabling details at all. Hence, neither Stierle, Cunningham, Puttre, nor Smith can render claim 8 unpatentable, regardless of what they recount, since they do not enable claim 8. Claim 8 is thus also submitted to be allowable. Withdrawal of the rejection of claim 8 is earnestly solicited.

Claim 35:

Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle, Cunningham, and Puttre and further in view of Smith. The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

Claim 35 depends from claim 3 and adds further distinguishing elements. Neither Stierle nor Cunningham teach, disclose, or suggest "obtaining, together with the various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data," as discussed above with respect to the rejection of claim 3. Smith does not either, and thus cannot make up for the deficiencies of either Stierle or Cunningham with respect to claim 35.

Furthermore, a reference must enable a claim in order to anticipate the claim, as discussed above. Here, neither Stierle, Cunningham, nor Smith do anything more than recount results produced by others, with no enabling details at all. Hence, neither Stierle, Cunningham, nor Smith can render claim 35 unpatentable, regardless of what they recount, since they do not enable claim 35. Claim 35 is thus also submitted to be allowable. Withdrawal of the rejection of claim 35 is earnestly solicited.

Claim 9:

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle and Cunningham, and further in view of Smith. The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

Claim 9 depends from claim 3 and adds further distinguishing elements. Neither Stierle nor Cunningham teach, disclose, or suggest "obtaining, together with the various CAD parts data provided by the server which are displayed on the Web browser in the client, URLs in which said various CAD parts data are published and information relating to said various CAD parts data as attributes of said various CAD parts data," as discussed above with respect to the rejection of claim 3. Smith does not either, and thus cannot make up for the deficiencies of either Stierle or Cunningham with respect to claim 9.

Furthermore, a reference must enable a claim in order to anticipate the claim, as discussed above. Here, neither Stierle, Cunningham, nor Smith do anything more than recount results produced by others, with no enabling details at all. Hence, neither Stierle, Cunningham, nor Smith can render claim 9 unpatentable, regardless of what they recount, since they do not

enable claim 9. Claim 9 is thus also submitted to be allowable. Withdrawal of the rejection of claim 9 is earnestly solicited.

New Claims:

Claims 37 to 40 depend from claim 1 and add further distinguishing elements. Claims 37 to 40 or thus believed to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1.

Claims 41 to 45, similarly, depend from claim 3 and add further distinguishing elements. Claims 41 to 45 are thus also believed to be allowable, for at least those reasons discussed above with respect to the rejection of claim 3.
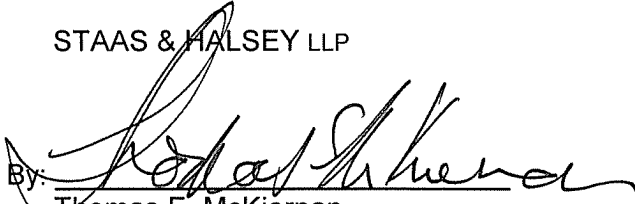
Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 3, 5-10, 12, 14-16, 18, 20-22, 24 and 26-45 are allowable over the cited references. If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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